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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,902	08/16/2000	David A. Chen	03399.P031	3353

7590 07/29/2004

Jordan M Becker  
Blakely Sokoloff Taylor & Zafman LLP  
12400 Wilshire Boulevard  
7th Floor  
Los Angeles, CA 90025

EXAMINER

BAYARD, DJENANE M

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/640,902

Applicant(s)

CHEN ET AL.

Examiner

Djenane M Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 25-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 25-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This office action is in response to the request for reconsideration filed on June 17, 2004, in which claims 1, 3-12 and 25-55 are presented for further examination.

### ***Response to Arguments***

2. Applicant's arguments filed June 17, 2004, with respect to the 102 rejections have been fully considered. The arguments with respect to the rejection under 102 are persuasive and the rejection has, therefore been withdrawn.

### ***Remark***

3. Applicant asserted that at the time of the invention of the present's applications filing data 8/16/00 Openwave System Inc did not exist yet. OpenWave Systems Inc was created on or about November 17, 2000 as a result of a merger of Phone.com with another company. Furthermore, Applicant asserted that the subject matter in Schwartz and the subject matter claimed in the present application were owned by or subject to an obligation of assignment to, the same person Phone.com at the time the invention was made. Therefore, the office after further examination, concluded that the claims of the pending application are substantially equivalent with the patent claims of Schwartz, except, the pending claims are broader, which in fact it is not interfere with the functionality of the steps previously claimed and would perform the same function.

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***Double Patenting***

4. The non statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 3-12 and 25-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of the U.S. Patent No. 6,473,609. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons: Claim 1 of the instant application substantially

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recites the limitations of claim 1 of the cited U.S. patent. The claim merely omits certain the underlined limitations and replaces the bolded limitations as shown in comparison table 1 below.

Application Claim 1	US Patent Claim 1
<p>a. As per claim 1, Schwartz et al teaches method of providing content from a network to a wireless device the method comprising: receiving the content from a resource on the network according to a hypermedia protocol, wherein the wireless device is not compliant with the hypermedia protocol; and converting the content to a message compliant with a message requirement of the wireless device, <b>including generating an SMS message including the content.</b></p>	<p>1. A method for an interactive two-way communication mobile device of a wireless network to interact with a network server, the mobile device having a display screen, the method comprising: initiating a control engine in a link server device coupled to a landnet after the mobile device establishes a communication session with the link server device over the wireless network, through a pair of first and second protocol interfaces, the first protocol interface residing in the mobile device and the second protocol interface residing in the link server device, the link server device comprising: <u>an account manager managing a user account of the mobile device; and a message processor receiving a message from the network server over the landnet; associating the control engine with an interface engine operating in the mobile device corresponding to the user account, and converting the message by the message processor to a compact data file that can be efficiently transportable in the wireless network, including substituting a uniform resource identifier in the message with a corresponding address identifier while maintaining the uniform resource identifier in the link server device.</u></p>

Table 1

It would have been obvious to one of ordinary skill in the art of two way communication devices at the time the invention was made to modify the cited steps as indicated in claim 1 of the US Patent since the omission of the underlined cited limitations would have not changed the

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process of receiving the content from a resource on the network according to a hypermedia protocol, wherein the wireless device is not compliant with the hypermedia protocol; and converting the content to a message compliant with a message requirement of the wireless device. Therefore, it would have been obvious to one with ordinary skilled art to modify claim 1 of the cited US patent by deleting the use of : an account manager managing a user account of the mobile device; and a message processor receiving a message from the network server over the landnet; associating the control engine with an interface engine operating in the mobile device corresponding to the user account, and converting the message by the message processor to a compact data file that can be efficiently transportable in the wireless network, including substituting a uniform resource identifier in the message with a corresponding address identifier while maintaining the uniform resource identifier in the link server device.

The cited omitting elements would not interfere with the functionality of the steps previously claimed and would perform the same function. In re Karlson, 136 USPQ 184 (CCPA 1963).

#### *Allowable Subject Matter*

Claims 1, 3-12 and 25-55 would be allowable upon filing a terminal disclaimer to overcome the double patenting rejection set forth in this office action.

#### *Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a)..

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (703) 305-6606. The examiner can normally be reached on 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard



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**RUPAL DHARIA**  
**SUPERVISORY PATENT EXAMINER**

A handwritten signature in black ink, appearing to read 'Rupal Dharia', with a long horizontal stroke extending to the right.